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PATENT

Docket No. H 5322 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: Kelders et al.
Appl. No.: 09/992,861
Filed: November 14, 2001
Grp./A.U.: 1734
Examiner: Linda Lamey Gray
Customer No.: 00423
Confirm. No.: 6008
Title: APPARATUS FOR DISPENSING A ROLL OF MATERIAL
AND METHOD OF USING THE SAME

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Applicants reply to the Office Communication mailed
August 10, 2004.

REMARKS

Reply to the Examiner's Responses

The Examiner's first response is that claims 1, 12, and 16 do not exclude from their scope the open hole disclosed by Taylor. Those claims indisputably require that the cover have a depression upon which a finger may be placed. The Examiner admits that the finger in Taylor contacts not the cover, but the roller. Thus the finger rests not upon a depression in the cover, but upon the roller poking through a hole in the cover. This is not resting upon a depression that is part of the cover as claimed. Therefore the claimed element and the structure in the art are not the same.

The Examiner next argues that claims 1, 12, and 16 do not claim that the finger may rest comfortably upon the depression, which may have ridges. The Examiner also points out that the hole in Taylor does form a part of its cover, and that applicants' claims do not recite that the index finger may rest upon the claimed depression. Applicants have not cited this description for the purpose of incorporating such limitations into the claims; rather, this description is cited as evidence in the application of how one of skill would interpret applicants' use of the term "depression" in the claims. Claim terms are to be interpreted in view of the description, not in a vacuum.

A hole as described in the art cannot be a depression as claimed since a hole can neither have ridges nor can a finger rest upon it (a feature, incidentally, that is recited in the claims at issue). The hole in Taylor is a void, through which something may pass, in which something may rest, but *upon* which nothing can rest. Applicants need not make explicit in the claims what is inherent in the use of the term depression as described in the application.

The Examiner next and later argues that the functional limitations recited in applicants' apparatus claims 1 and 12 have no "structural impact" on the claimed apparatus. Applicants strongly disagree, because a depression upon which a finger may be rested must inherently have a surface upon which the finger can rest. Thus the recited function has direct structural impact on the claimed device. Moreover, the inclusion of this structural feature in the claimed element is reinforced by the ability of the depression to have ridges, a physical impossibility for a void.

As for the method claim 16 and those depending from it, there can be no doubt that in use the claimed depression functions in an entirely different manner during dispensing of material from the apparatus. The user's thumb in Taylor contacts the roller and ring projecting through the hole not to "rest comfortably" but to move these elements. Resting a finger or thumb in this hole during dispensing would stop the feed roller and prevent discharge of the tape from the supply roll during

application to a substrate. This access hole for intermittently operating the feed roller does not provide a surface upon which to comfortably rest a finger during dispensing. It is structurally and functionally different from what is claimed.

The next response by the Examiner is that the claims do not provide that the finger is upon the cover piece when placed in the depression. This argument is not understood. As the claims provide, the cover piece "has" a depression. Is it seriously argued that where a cover piece "has" a depression, and a finger rests upon the depression, that the finger does not rest upon the cover piece?

The Examiner adds that the claimed depression does not have a surface because the surface is not explicitly claimed. As pointed out above, this feature is inherent in the description of the depression found in the application. Applicants need not, and in fact are discouraged, from including extraneous matter in the claims. Because a finger cannot rest upon a depression in a cover piece without that very same depression having a surface upon which a finger can rest, the surface need not be explicitly recited. It is inherent in applicants' use of the word "depression."

The Examiner next argues that Taylor teaches applicants' method steps in claim 16. This is not correct since the structural limitation of the apparatus that form substantive limitations upon the method are not taught or

suggested by the reference. Specifically, as pointed out above, Taylor does not describe or suggest the claimed depression.

The Examiner next attempts to clarify a prior argument, stating "that the pending claims do not require there to be a cover piece in the depression upon which the finger rests" This argument misses the point. Applicants claim a cover piece that has a depression (having a surface inherently) upon which finger may rest.

As to the Examiner's arguments regarding claim 14, Applicants point out that one cannot interpret the prior art to reach the claims and in doing so impose a construction of the art that is at odds with its plain disclosure or inconsistent with the common sense attributed to one of skill in the art. How the cited structures in Taylor were intended to be used is not explained in the reference itself, but, as pointed out previously, the manner of use inherent in the Examiner's interpretation of Taylor's Figure 3 makes no sense.

Figure 3 shows an end view of long, narrow indentations on either top edge of the cover piece. This end view distorts the true proportions of the indentations, which are apparent when one looks at the side view in Figure 1. There it is seen that the area of these "depressions" is far too narrow to fit a finger. A user attempting to grasp the device between the thumb and middle or forefinger by these indentations on the cover would gain

no hold from the indentations and be unable to support or usefully manipulate with their other fingers the vast balance of the device that remains. It is an object of Taylor to avoid "the inability of a user to fully manipulate the device with the hand that holds it." Taylor, col. 2, ll. 7-11.

Holding the Taylor device in the manner suggested by the rejection of claim 14 also directly contradicts Taylor's explicit teaching of how its device is held. The user cannot grasp the device between thumb and finger(s) on the cover indentations and at the same time access the opening (32) with the thumb, without first holding the device in the other hand and defeating the object of one-handed feeding, applying, and cutting of tape. Taylor, col. 1, lines 6-10, col. 3, lines 46-50. For these reasons, Figure 3 of Taylor does not disclose one or more depressions on the sidewalls for placement of a thumb or fingers to anticipate claim 14.

CONCLUSION

For the reasons stated above, the Examiner's final rejection of claims 1, 3-8, and 10-20 should be reversed. Should any fees be due for entry and consideration of this Amendment that have not been accounted for, the

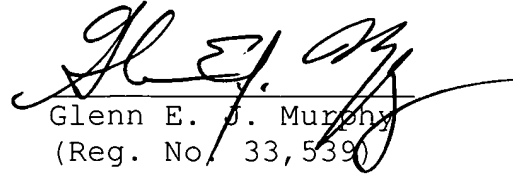
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Reply Brief dated October 12, 2004

Reply to Office Communication of August 10, 2004

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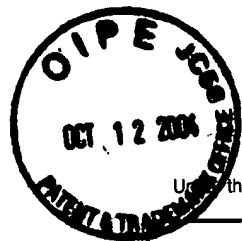
Respectfully submitted,

A handwritten signature in black ink, appearing to read "Glenn E. J. Murphy", is written over a horizontal line.

Glenn E. J. Murphy
(Reg. No. 33,539)
Attorney for Applicants
610-278-4926

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Henkel Corporation
Patent Law Department
2200 Renaissance Blvd., Suite 200
Gulph Mills, PA 19406

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